

**REMARKS**

**I. CLAIMS 1, 8, 10-11, 18, 20-21, 23-26, 29, AND 36-46 ARE NOT ANTICIPATED**

Claims 1, 8, 10-11, 18, 20-21, 23-26, 29, and 36-46 have been rejected as anticipated under Section 102(e) by U.S. Patent No. 6,075,844 to Goldberg et al. ("Goldberg et al."). For the reasons set forth below, Applicants respectfully traverse the rejections based on Goldberg et al.

**A. Claims 1, 8, 10-11, 18, 20-21, 23-26, 29, 36, And 44-46 As Amended Are Not Anticipated**

Independent Claims 1, 11, 21, and 29, have been amended to require that the portable digital audio recorder itself automatically generate the header data used to identify the destination of the voice data file. Support for this amendment is found in the specification on page 12, lines 9-13. In contrast, the intended message recipient in Goldberg et al. can only be identified if a pre-defined spoken header is inserted prior to the creation or dictation of the actual message that will be sent. Goldberg et al., therefore, does not disclose a header that can be automatically generated by the portable recorder device itself. This amendment is believed to obviate the Section 102(e) rejections of Claims 1, 8, 10, 11, 18, 20-21, 23-26, 29, 36, 44-46. Accordingly, Applicants respectfully request that the Examiner's rejection of Claims 1, 8, 10, 11, 18, 20-21, 23-26, 29, 36, and 44-46 based on Goldberg et al. be withdrawn.

**B. Claims 37, 39, 40, and 43 As Amended Are Not Anticipated**

Independent Claims 37 and 40, as currently amended, require the portable audio recorder to apply the speech recognition algorithm to the recorded recipient information voice data to generate the recipient data (specification page 15, lines 6-15). As a result, when the voice data is subsequently uploaded to a personal computer, the computer reads the recipient data and forwards the voice file data to the recipient indicated by the recipient data without further speech processing of the recipient data. Goldberg et al. does not disclose that the pre-defined spoken message header can be analyzed in the recorder to determine the recipient data for the message. In fact, Goldberg et al. clearly states that the speech recognition software is stored on the sending party's personal computer (Goldberg col. 3, lines 51-54) and that the sending party's personal computer, not the recorder, applies the speech recognition software to the pre-defined spoken

message header to determine the identity of the intended recipient (Gold erg et al. col. 4, lines 20-27). This amendment is believed to obviate the rejections of Claims 37, 39, 40, and 43.

Accordingly, Applicants respectfully request that the Examiner's rejection of Claims 37, 39, 40, and 43 based on Goldberg et al. be withdrawn.

## **II. CLAIMS 9, 19, 27 AND 35 ARE NOT OBVIOUS**

The Examiner has rejected Claims 9, 19, 27, and 35 as obvious under Section 103(a) in view of the combination of Goldberg et al. and U.S. Patent No. 5,989,916 to Breslawsky ("Breslawsky"). The Examiner stated that Goldberg et al. discloses all of the elements of Claims 9, 19, 27, and 35 except a central dictation system which is disclosed by Breslawsky. More specifically, the Examiner stated that a "central dictation system would help to have more users recording voice data; therefore, it would have been obvious . . . to modify Goldberg using the central dictation system as taught by Breslawsky. The modification will help more users accessing the system such that service provider may have the possibility to record and process voice data files in a voice data management system." To the extent understood, Applicants traverse the Examiner's obviousness rejections because there is no teaching or suggestion in Goldberg et al. and Breslawsky themselves to combine the references. The Examiner has not provided any support for his apparent position that it would be obvious to add the central dictation system of Breslawsky to the system of Goldberg simply because more users could record voice data. The Examiner's rejection falls short of pointing to a teaching or suggestion to make the claimed combination and a reasonable expectation that such a combination would be successful as required by *In re Vaeck*, 947 F.2d. 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Therefore, the Examiner's proposed combination of Goldberg et al. and Breslawsky is not proper, and the rejections of Claims 9, 19, 27, and 35 under Section 103 should be withdrawn.

## **III. CLAIM 47 IS SUPPORTED BY THE SPECIFICATION**

New Claim 47 is dependent on Claim 1, and adds the further limitation that the header data which is automatically generated by the portable digital audio recorder is based on information manually entered into the recorder. New Claim 47 is supported by the disclosure in specification on page 15, lines 23-25. Moreover, Applicants respectfully believe that Claim 47 is


patentable over Goldberg et al. because this reference only discloses header or recipient data entered via voice.

#### IV. CONCLUSION

In view of the above amendments and remarks, Applicant believes claims 1, 8-11, 18-21, 23-27, 29, 35-37, 39-40, and 43-47 are in position for allowance and respectfully requests that a timely Notice of Allowance be issued in this case.

Enclosed is a Petition for Extension of Time (three months). Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Kelley Drye & Warren LLP Deposit Account No. 11-0404, Order No. 018632.0091.NPUS00.

Respectfully submitted,

By   
Katherine L. Tabor  
Reg. No. 36,026  
Kelley Drye & Warren LLP  
333 W. Wacker Dr., Ste. 2600  
Chicago, IL 60606  
(312) 857-7070  
(312) 857-7095 (Fax)  
Attorneys for Applicant